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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,615

12/22/2003

Mark S. Garrison

680.0039USQ

7572

7590

07/05/2006

CHARLES N.J. RUGGIERO, ESQ.  
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.  
ONE LANDMARK SQUARE, 10TH FLOOR  
STAMFORD, CT 06901-2682

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,615	<b>Applicant(s)</b> GARRISON, MARK S.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 22 and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 22 and 24 do not further limit claim 1 as the claim limitations on the vapor pressure and boiling point of the volatile compound, respectively, are already recited in the base claim, claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bara et al. (US 6224851 B1) in view of Occupational Safety & Health Administration data (Chemical Sampling Information: Ethyl Perfluorobutyl Ether), Tsutsumi et al. (English translation, JP 356079613A), and Bretescu (US.6528070 B1).**

Claim 1 is directed to an oil and water emulsion comprising a volatile compound having a vapor pressure about 20-500 mbar at 25 °C and a boiling point about 45-110 °C, wherein the volatile compound does not totally dissolve in water or oil, and wherein

Art Unit: 1617

the composition has a viscosity from about 5000 cps to about 2,500,000 cps. Claim also recites that the composition has "textured surface appearance" which is "disturbed after each use of the composition provided the disturbed composition is maintained for a pre-determined period of time in the sealed container".

Bara teaches cosmetic water-in-oil emulsion foundation comprising 20 % by weight of perfluoromethylcyclopentane. See col. 8, Example 2; instant claims 1, 13-15, 19, 21, 26, 32, 38, 39. Oil-in-water emulsion is also taught in col. 6, lines 11-25; instant claim 2. The reference teaches, "the perfluoromethylcyclopentane can advantageously be replaced with an equivalent amount of ethoxynonafluorobutane", which is is ethoxy perfluorobutane, another name for ethyl perfluorobutyl ether, commercially available as HFE 7200 by Novec. See col. 3, lines 21-26; instant claims 17, 18, 32, 33, 39. The weight of the volatile components in the composition are disclosed in col. 8, lines 48-51. See instant claims 26-31 and 34-35.

For claims 20, the idea for combining compounds each of which is known to be useful for the same purpose, in order to form a composition which is to be used for the same purpose, flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings the instant claims define nothing more than the concomitant use of conventional perfluoro oil compounds that are interchangeably used in the same cosmetic composition. Thus it would follow that combining partially fluorinated and perfluorinated compounds defines a prima facie obvious subject matter.

Claim 12 recites how the composition 1 is to be used as “facial cream, a body cream, a facial mask, and a cleansing cream”. These terms denote the intended future use or the purpose, rather than structural limitation of the composition. Thus no patentable weights are given to these terms. MPEP 2111.02. As for claims 9-11, 36, and 37, the claims define how the composition is stored and used, rather than how the composition is defined and thus lacks structural limitation. Also claim 39 recites that the composition is “in a container that seals against escape of pressure from the container for a pre-determined period of time”. Regardless of how the composition is stored, the claimed subject matter is a composition. No patentable weights are given to these phrases.

For claim 16, the perfluorocycloalkyl compound of instant claim (I) is perfluoromethyl-cyclohexane when  $n$  is 5 and both  $p$  and  $m$  are 1. See col. 2, lines 19 – 31.

The reference teaches that the fluorinated solvents disclosed therein have vapor pressure that is greater than 20 mbar at 25 °C and boiling points between 20-75 °C, thus the reference suggests that perfluoromethylcyclopentane and ethoxy- and methoxynonafluorobutane are within this limitation. See col. 2, lines 8 – 14; col. 3, lines 14 – 18. The reference is silent as to the specific vapor pressure of the volatile perfluoro solvents.

OSHA data teaches that ethyl perfluorobutyl ether has vapor pressure of 109 mmHg (145.32 mbar) at 25 °C. See instant claims 22, 23.

Art Unit: 1617

Bara does not teach the specific viscosity of the composition. Since the emulsions are “preferably in the form of creams”, a skilled artisan would have been motivated to formulate the invention in the viscosity range of conventional cream composition well known in the art.

Bratescu teaches that the viscosity of cosmetic emulsion composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps. See col. 13, lines 33-35. See instant claims 1, 3-7, 32, 38, 40, 41. Thus formulating the Bara composition in the viscosity range as taught by Bratescu would have been obvious to the skilled artisan.

Bara does not indicate the “texture” of the composition.

Examiner views that the prior art composition which contains the same volatile component in the same amount as applicant’s invention necessarily possesses the same texture characteristic as the claimed by applicant. Alternatively, Tsutsumi teaches that whipped stable cosmetic that is “without oil off and shape collapse” is well known in the art. See p. 3, bridging par. While the reference teaches that the whipped cosmetic may be used in a lipstick, foundation, emulsion or cream without emulsifier, there is no teaching of using an aerosol container. See Constitution. See instant claim 29. The whipped stable composition is said to be without “shape collapse”, which is viewed to be equivalent property to the claimed textured surface-renewing property. The reference teaches in p. 11 that the invention is also applicable to other cosmetics such as cream and emulsion cosmetics containing surfactants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Bara by producing a whipped

Art Unit: 1617

composition as motivated by Tsutsumi because 1) both references teach cosmetic emulsion and cream form of foundation; 2) Tsutsumi teaches the benefit of stability of the composition in terms of phase separation and shape; 3) and the skilled artisan would have had a reasonable expectation of successfully producing a stable whipped cosmetic composition comprising perfluorinated and/or fluoroether volatile compounds.

**Claims 38, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bara in view of Occupational Safety & Health Administration Data, Tsutsumi, Bretescu, and Morrisou (US 2859085).**

Bara, Occupational Safety & Health Administration Data, Tsutsumi and Bretescu are discussed above. The references fail to teach a system comprising a container and a sealable and removable cap.

Morrisou teaches that containers for facial creams are conventionally in the form of jar and removable lid. See Figure.

It would have been obvious to one of ordinary skill in the art at the time the present invention was made to store the whipped cosmetic composition of the combined references in a container with a jar as suggested by Morrisou to protect the composition. The claimed method of "imparting a self-renewing and self-leveling textured surface appearance to a composition after each use" by "maintaining the composition in a capped state for a pre-determined period of time after each use to allow the composition to self-renew and self-level the textured surface appearance of the composition" is viewed obvious over the normal and ordinary use of the composition of the combined references. It is obvious that the cosmetic composition is stored as

Art Unit: 1617

capped state after each use; and it is viewed that such self-renewing and self-leveling as claimed by applicant would obviously occur in the composition made as motivated by the combined references.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 7:00AM until 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

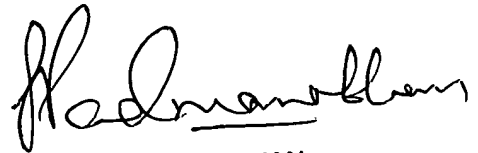
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Application/Control Number: 10/743,615  
Art Unit: 1617

Page 8

Gina Yu  
Patent Examiner

A handwritten signature in black ink, appearing to read 'S. Padmanabhan', with a horizontal line under the last name.

**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**